

REMARKS/ARGUMENT

Claims 1-3, 17-22 and 24-49 are currently pending.

The Office Action rejected the pending claims under 35 U.S.C. § 103 as obvious over U.S. patent 5,879,684 ("Fox") in view of U.S. patent 5,468,477 ("Kumar"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The rejection in the Office Action does not set forth a *prima facie* case of obviousness. The Office has previously recognized that Fox does not relate in any way to the claimed polymers. Thus, nothing in Fox teaches or suggests using an effective amount of the claimed grafted silicone polymers to reduce cutaneous signs of aging. Furthermore, Fox relates to tensor agents, and tensor agents are different from film-forming agents. That is, not all tensor agents are film-forming agents, and *vice versa*. Thus, Fox's disclosure concerning tensor agents neither teaches nor suggests any utility for Kumar's film-forming polymers. Accordingly, the combination of Fox and Kumar cannot yield the claimed invention.

Furthermore, to support this rejection, the Office Action has taken the position that because Kumar's film-forming polymers were known to have certain properties with respect to hair care, using such polymers to reduce signs of cutaneous aging would have been obvious. That is, the Office Action has apparently taken the position that Kumar's disclosing the use of film-forming polymers for treating hair would render obvious all other, completely different uses of such polymers. This is certainly not the law, nor could it possibly be the law -- under such an interpretation, method of use claims directed to novel uses of existing compounds would never be patentable because the compounds were already known. It is

well-settled that new uses of existing compounds are entitled to patent protection. Such a novel use of known polymers is what the claims of the present application are directed to -- the pending claims directed to reducing cutaneous signs of aging cannot be taught or suggested by the applied art which is directed to completely different uses.

In view of the above, Applicants respectfully submit that no *prima facie* case of obviousness exists.

However, even assuming a *prima facie* case of obviousness has been set forth, the surprising and unexpected results associated with the claimed invention are more than sufficient to rebut any such hypothetical *prima facie* case of obviousness. Specifically, as detailed in the Rule 132 declaration submitted with Applicants' September 20, 2006, response, invention compositions possessed significantly higher tensioning effect than comparative compositions, and this vast difference in tensioning effect among the different polymers was surprising and unexpected given the similarity of the compositions and the similarity of the moieties in the polymers.

Furthermore, submitted concurrently herewith is a new Rule 132 declaration further demonstrating the superior properties associated with the claimed invention. This new declaration, like the previous Rule 132 declaration, demonstrates that that the invention composition provides significant tensioning action, particularly as compared to the three comparative compositions tested. Specifically, Comparative Compositions B and C did not exhibit any tensioning effect. (Rule 132 dec., par. 7). Furthermore, as compared to Composition D, Composition A had 50% numerically higher tensioning effect value after 3 hours, and 37.5% numerically higher tensioning effect value after 24 hours. (Rule 132 dec.,

par. 7). Thus, Invention Composition A possessed significantly higher tensioning effect than Comparative Compositions B-D. (Rule 132 dec., par. 7).

The new Rule 132 declaration also compared the tensioning effect of Invention Composition A and Comparative Composition D at different concentrations (4.5% and 2%). (Rule 132 dec., par. 8). Invention Composition A at both 4.5% and 2% concentrations provided significantly better tensioning action compared to Comparative Composition D. (Rule 132 dec., par. 9).

This vast difference in tensioning effect among the different polymers was surprising and unexpected given the similarity of the compositions and the similarity of the moieties in the polymers. (Rule 132 dec., par. 10). Also, this difference in tensioning effect demonstrates that not all film forming agents are effective tensioning agents. (Rule 132 dec., par. 10).

In view of the above, Applicants respectfully submit that a sufficient showing of unexpected and surprising results has been made to overcome any hypothetical case of *prima facie* case of obviousness which may exist. Nothing in any of the applied art teaches or suggests using the effective amounts of the claimed polymers with the intent of reducing cutaneous signs of aging/wrinkles, let alone that the claimed polymers would possess surprising and unexpected properties in this regard. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

The Office Action also rejected claim 34 under the judicially created doctrine of double patenting over claims 1, 16 and 27-29 of U.S. patent 6,022,836 ("the '836 patent"). In

Application Serial No. 09/533,361
Response to Office Action dated January 14, 2008

view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The '836 patent relates to compositions for hair, not skin. Because these compositions are not applied to skin, they cannot contain a signs of cutaneous aging reducing effective amount of the required polymer as required by the claims. That is, the compositions in the '836 claims would not be effective in reducing signs of cutaneous aging. According to the Federal Circuit, such a composition cannot contain a signs of cutaneous aging reducing effective amount. *See, Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*, 67 U.S.P.Q.2d 1191 (Fed. Cir. 2003)(“effective amounts” are not necessarily disclosed by prior art compositions containing the claimed active ingredient; the desired effect must be achieved). Therefore, the compositions in the claims of the '836 patent cannot teach or suggest the claimed composition.

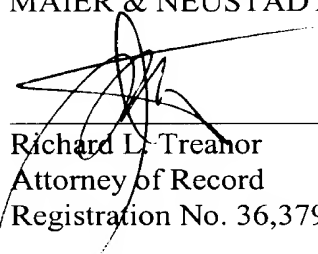
In view of the above, Applicants respectfully request reconsideration and withdrawal of the pending double patenting rejection.

Application Serial No. 09/533,361
Response to Office Action dated January 14, 2008

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel #: (703) 413-3000
Fax #: (703) 413-2220